

REMARKS

Applicant has carefully studied the Final Office Action of January 7, 2004 and offers the following remarks to accompany the above amendments. Applicant appreciates the telephonic interview of February 23, 2004. Where appropriate, comments from the interview are incorporated and addressed below.

Initially, Applicant amends claims 18-25, 27, and 28 to correct typographical errors. No new matter is added.

Applicant also amends independent claims 1, 17, and 29 to include the subject matter of claims 10, 26, and 38, respectively. Claims 10, 26, and 38 are canceled as redundant in light thereof. Furthermore, independent claims 1, 17, and 29 have been amended to include a definition of "software". This definition comes from the Dictionary of Communications Technology, copyright 1998. A copy of the coversheets for the Dictionary as well as the page defining the term "software" is attached for the Patent Office's convenience.

During the telephonic interview, Applicant discussed the definition of "software". The Patent Office maintained that software, absent a qualifier, included data and supported this definition with a citation to an IEEE definition. Applicant respectfully maintains that this definition is overly broad, and no one of ordinary skill in the art considers a data file to be software. Applicant respectfully maintains that software requires execution and a data file cannot execute. While a computer program can operate on a data file, the data file itself is incapable of independent execution. The Patent Office further maintained during the interview that data files have instructions which are executable. Specifically, the Patent Office opined that, for example, a ".doc" file had formatting instructions therein that amounted to instructions which, when executed, acted upon the data. However, Applicant respectfully traverses this construction. The formatting instructions present in a ".doc" file are not independently executable. That is, a computer that reads a ".doc" file without the benefit of MS WORD or comparable word processing program cannot do anything with the formatting instructions. Only by having MS WORD (or comparable word processing program) execute on the .doc file are the instructions realized. Thus, the instructions do not automatically execute as recited in the claims. However, to further the prosecution of the present case, Applicant has amended the independent claims to clarify the intended purpose of the term "software" and effectively exclude non-executing data files from the claim.

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Claims 1, 5-9, 11-15, 17, 21-25, 27-29, 33-37, 39, and 40 were rejected under 35 U.S.C. § 102(e) as being anticipated by Herrendoerfer. Applicant's amendments to claims 1, 17, and 29 and the inclusion of claims 10, 26, and 38 therein respectively moots this rejection. Applicant requests withdrawal of the § 102 rejection of these claims at this time.

Claims 2-4, 18-20 and 30-32 were rejected under 35 U.S.C. § 103 as being unpatentable over Herrendoerfer in view of Suga et al. The amendments to the independent claims make this rejection moot. Applicant requests withdrawal of the rejection to claims 2-4, 18-20 and 30-32 at this time.

Claim 16 was rejected under 35 U.S.C. § 103 as being unpatentable over Herrendoerfer in view of Yee et al. The amendment to independent claim 1 makes this rejection moot. Applicant requests withdrawal of the rejection to claim 16 at this time.

Claims 10, 26, and 38 were rejected under 35 U.S.C. § 103 as being unpatentable over Herrendoerfer in view of Zubeldia et al. Applicant respectfully traverses. Since the subject matter of claims 10, 26, and 38 have been placed into claims 1, 17, and 29, Applicant responds to this rejection with reference to amended claims 1, 17, and 29.

For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every claim element is located in the combination of references. MPEP § 2143.03. Furthermore, before the Patent Office can combine references, the Patent Office must 1) provide a motivation to combine the references, and 2) provide actual evidence that supports the motivation to combine the references. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

Applicant notes that the Patent Office opines that the motivation to combine Herrendoerfer with Zubeldia et al. is to increase the protection of a user's privacy (Office Action, page 5, line 5). This motivation is not supported by the requisite actual evidence and thus is improper. Absent the requisite actual evidence, the combination cannot be made. Since the references individually do not teach or suggest all the claim elements, the Patent Office has not established *prima facie* obviousness and the claims are allowable. Furthermore, it is readily apparent that this motivation comes straight from Applicant's disclosure. E.g., claim 10 recites "to enhance privacy" and the Patent Office's analysis is "to increase privacy." This sort of hindsight reconstruction using Applicant's disclosure as a template is impermissible. Applicant requests withdrawal of the rejection on these bases.

Applicant further traverses the rejection because Zubeldia et al. does not teach the claim element for which it is recited. Specifically, the Patent Office admits that Herrendoerfer does not teach or suggest removing records. The Patent Office relies on Zubeldia et al., col. 1, lines 32-34 for this element. However, a close examination of the cited passage reveals that Zubeldia et al. contemplates "removal of personally identifying information from data records," not the removal of the records as recited in the claim. To this extent, the references individually do not teach or suggest a claim element. Thus, in combination, the references cannot teach or suggest the claim element, and the Patent Office has not established *prima facie* obviousness. Applicant requests withdrawal of the rejection on this basis.

Applicant further traverses the rejection in light of the amendments to the claims. Specifically, the amended definition of "software" highlights the differences between the software of the claims and the data files of Herrendoerfer. This position was previously argued. Specifically, Herrendoerfer discloses a data file. While a program may execute on the data file, the data file itself does not automatically execute as recited in the claim, and is certainly not a program as now recited in the claims. Thus, Herrendoerfer does not teach or suggest the automatically executing software of the claims. Nothing in Zubeldia et al. cures this deficiency. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element and the Patent Office has not established obviousness. Applicant requests withdrawal of the rejection on this basis. As this position was previously argued, this should not constitute a new issue. MPEP § 904.

Applicant respectfully requests reconsideration of the rejection in light of the amendments and arguments presented herein. The references of record do not teach or suggest automatically executing software programs and do not teach or suggest the removal function currently recited in the independent claims. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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DICTIONARY OF COMMUNICATIONS TECHNOLOGY

**Terms, Definitions and Abbreviations
Third Edition**

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4-Degree Consulting
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SOP

If the number of soft errors reaches the ring error limit, reliability is affected.

soft font Fonts that are stored on disk and loaded into a printer's memory for use.

soft link An alternate name for an object or directory in a namespace. Soft links allow users to view names as forming an acyclic directed graph rather than a pure tree.

Soft-Switch Central A product of Soft-Switch, Inc. of Wayne, PA. which enables over 40 proprietary electronic mail systems to be interconnected.

soft turn-off A soft carrier frequency transmitted by a modem operating on the switched telephone network to prevent transients at the end of a message being misinterpreted as spurious space signals at the remote modem.

softcopy An electronic document that is stored in a computer.

Softerm PC A communications program marketed by Softronics, Inc., for use on the IBM PC and compatible personal computers. The program is known for its inclusion of over 50 exact terminal emulations and seven file transfer protocols.

software A computer program or set of computer programs held in some kind of storage medium and loaded into read/write memory (RAM) for execution.

software defined network A network constructed by a long distance carrier, in which a user is given a means to define a "virtual network" that operates in some respects as a private network, yet is assembled from conventional switching and trunking components of the carrier's public switched network.

Software Defined Network Services (SDNS) An AT&T provided service that gives customers control of their own special call-routing programs stored in AT&T's network. This will provide fast and cost-effective network flexibility.

software demultiplexing In multiplexer applications, the connection of a computer directly to a multiplexer trunk without an intervening multiplexer to permit the remotely multiplexed transmission to be demultiplexed by software running within the computer.

software engineering A broadly defined discipline that integrates the many aspects of programming, from writing code to meeting budgets, in order to produce affordable software that works.

software maintenance The continual improvements and changes required to keep programs up to date and working properly.

SO Shift-Out.

SOH Start Of Header.

solar array A power generation method using solar cells.

solar outage A condition in which the high radiated noise level of the sun can be many times stronger than a transmitted signal. In satellite transmission a solar outage occurs when the sun passes behind or near a satellite and within the field of view of an antenna. Satellite solar outages are predictable and occur twice a year.

solar panel A device on satellites that converts solar energy into electrical energy.

solder A metal or metallic alloy used, when melted, to join two or more metallic surfaces.

solicited message In IBM's ACF/VTAM, a response from VTAM to a command entered by a program operator.

solid-state component A component whose operation depends on control of electric or magnetic phenomena in solids such as a transistor, crystal diode or a ferrite core.

SOM Start Of Message.

SONET Synchronous Optical NETwork.

SOP Standing Operating Procedure.